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OFFICE OF PETITIONS

In re Application of :
Inada and Kubo :
Application No.: 10/781,263 : **ON PETITION**
Filing Date: February 19, 2004 :
Attorney Docket No. 087147-0494 :

This is a decision on the "Petition under 37 CFR 1.47 and 1.182" filed September 10, 2008, which will be treated as a petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.67 and 37 CFR 1.175.

The petition is **dismissed**.

Petitioner requests that the supplemental reissue declaration be accepted without the signature of the joint inventor Inada as petitioner alleges he cannot be located after diligent effort. In such a case, Section 1414.01 of the *Manual of Patent Examining Procedure* (MPEP) provides that:

[if] a joint inventor refuses or cannot be found or reached to sign a supplemental oath/declaration, a supplemental oath/declaration listing all the inventors, and signed by all the available inventors may be filed provided it is accompanied by a petition under 37 CFR 1.183 along with the petition fee, requesting waiver of the signature requirement of the non-signing inventor.

Accordingly, the instant petition will be treated as petition under 37 CFR 1.183 to waive the requirement of 37 CFR 1.175 so as to accept the supplemental reissue declaration filed September 10, 2008, without the signature of inventor Inada. It is noted that provisions of 37 CFR 1.47 do not apply in this instance and said provisions are only applicable to the original filing of a declaration under 37 CFR 1.63. However, the requirements for establishing that a non-signing inventor has refused, or cannot be located, to sign the supplemental declaration are the same as the requirements of 37 CFR 1.47, as set forth in Section 400 of the *Manual of Patent Examining Procedure*. Petitioner has not made a showing that inventor Inada cannot be located to sign the supplemental declaration. Petitioner has indicated that correspondence has been sent to the inventor's last known address and that the correspondence has been returned because of inventor's Inada's absence. Petitioner has not demonstrated that the address to which petitioner is sending the correspondence is the best address for the non-signing inventor and that petitioner has made a diligent effort to find that address. Further to this point, Section 409.03(d) of the *Manual of Patent Examining Procedure* (MPEP), provides, in pertinent part, that:

[w]here inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

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The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as **Internet searches**, certified mail, return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. **The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts.**

The renewed petition should be accompanied by a showing as to inventor Inada that satisfies the requirements provided above.

The fee for the instant petition is \$400.00. Deposit account 19-0741 will be charged an additional \$200.00, accordingly.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

Telephone inquiries regarding this matter should be directed to the undersigned at (571) 272-3222.



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